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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,716	03/30/2001	Thomas M. Sirhall	SMQ-058	7464
959	7590	10/20/2004	EXAMINER	
LAHIVE & COCKFIELD, LLP. 28 STATE STREET BOSTON, MA 02109			YIGDALL, MICHAEL J	
			ART UNIT	PAPER NUMBER
			2122	

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/823,716

Applicant(s)

SIRHALL, THOMAS M.

Examiner

Michael J. Yigdal

Art Unit

2122

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office action is in reply to Applicant's response and amendment filed on June 25, 2004. Claims 1 and 2 have been canceled. Claims 3-24 remain pending.

Response to Arguments

2. Applicant's arguments have been fully considered but they are not persuasive.

Applicant submits that Sonnenfeld does not teach permitting a predetermined number of attempts by the user to enter a correct answer (page 8, second paragraph). Applicant similarly contends that a security feature directed toward controlling who can take an entire test or the number of times an entire test can be taken (as taught by Sonnenfeld) does not anticipate a list software tool permitting a predetermined number of attempts by a user to enter a correct answer to a question (page 8, third paragraph).

However, Sonnenfeld discloses permitting a predetermined number of times the user can work on or take a "test part" (see column 30, lines 35-54). As defined by Sonnenfeld, a test has zero or more test parts, and a test part has zero or more sections that have zero or more questions (see column 15, lines 57-60). Accordingly, a test part is not necessarily the entire test and may in fact consist of one question. Therefore, Sonnenfeld anticipates permitting a predetermined number of attempts by the user to work on a question. To work on a question is to enter an answer to the question.

Applicant further submits that Sonnenfeld does not teach or suggest a list software tool automatically providing a correct answer in an answer box after the user surpasses a predetermined number of attempts, and that the option to display answers upon test completion

(as taught by Sonnenfeld) does not anticipate providing a correct answer in the answer box to a question after a user surpasses a predetermined number of attempts (page 9, first paragraph).

However, Sonnenfeld discloses “progressive” or “adaptive” tests in which parts of the test are scored before the test is completed (see column 21, lines 15-27). Sonnenfeld further discloses showing the answers to questions after providing a score (see column 22, lines 39-42). In other words, Sonnenfeld teaches providing the correct answers to questions as the questions are attempted and scored, before the test is completed. As set forth above, Sonnenfeld teaches permitting a predetermined number of attempts by the user to answer a question. Therefore, Sonnenfeld anticipates providing a correct answer to a question after the user surpasses the predetermined number of attempts, such as in the case of a progressive or adaptive test.

Applicant further submits that Sonnenfeld does not teach or suggest preventing a user from entering an answer after the predetermined number of attempts, and that Sonnenfeld does not anticipate taking any action after a user surpasses a predetermined number of attempts (page 9, second paragraph).

However, as above, Sonnenfeld discloses permitting a predetermined number attempts. Specifically, Sonnenfeld discloses that the user is allowed to work on part of the test a predetermined number of times, from zero times to an unlimited number of times (see column 30, lines 35-54). The user is inherently prevented from working on the test part when the user surpasses the predetermined number of attempts. If the user were for some reason not prevented from exceeding the predetermined number of attempts, as suggested by Applicant, any number other than “unlimited” would serve no purpose. Therefore, Sonnenfeld anticipates preventing a user from entering an answer after the predetermined number of attempts.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 3-24 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat. No. 6,112,049 to Sonnenfeld (art of record; herein “Sonnenfeld”).

With respect to claim 3 (currently amended), Sonnenfeld discloses, in an electronic device that provides an on-line educational course (see the title and abstract, and column 8, lines 61-67, which shows providing academic instruction using the Internet), a method comprising:

(a) providing an interactive list software tool, wherein the software tool generates a graphical user interface displaying a question and an answer box to a user to select at least one answer to the question in the answer box (see column 4, lines 37-44, which shows providing questions and interactively gathering responses, and lines 63-66, which further shows that the presentation, i.e. the graphical user interface, is automated or generated; see also column 5, lines 37-45, which shows that the multiple choice questions allow the user to select one or more, i.e. at least one, answer, and column 13, lines 53-63, which further shows that the fields may be in the form of list boxes); and

(b) forwarding the list software tool from the electronic device to a remote client (see column 10, lines 28-41, which shows forwarding the data from the host device to a client);

(c) wherein the list software tool permits a predetermined number of attempts by the user to enter a correct answer (see column 30, lines 35-54, which shows permitting a predetermined number of attempts by the user to work on a test part, i.e. to enter a correct answer, and column 15, lines 57-60, which further shows that a test part may be defined as one question).

With respect to claim 4 (original), Sonnenfeld further discloses the limitation wherein the list software tool automatically provides a correct answer in the answer box after the user surpasses the predetermined number of attempts (see column 22, lines 39-42, which shows providing the answers to questions after providing a score, and column 21, lines 15-27, which shows providing a score for part of the test before the test is completed; see also column 30, lines 35-54, which shows permitting a predetermined number of attempts for such test parts).

With respect to claim 5 (original), Sonnenfeld further discloses the limitation wherein the list software tool prevents the user from entering an answer after the predetermined number of attempts (see column 30, lines 35-54, which shows permitting a predetermined number of attempts by the user to work on a test part, i.e. limiting the number of attempts by the user to enter an answer; note that the user is inherently prevented from entering an answer when the limit is reached).

With respect to claim 6 (currently amended), Sonnenfeld further discloses the limitation wherein the list software tool is an applet (see column 3, lines 12-20, which shows that parts of the system may comprise applets).

With respect to claim 7 (currently amended), Sonnenfeld discloses, in an electronic device that provides an on-line educational course (see the title and abstract, and column 8, lines 61-67, which shows providing academic instruction using the Internet), a method comprising:

(a) receiving a request for a Web page at the electronic device from a remote client (see column 12, line 56 to column 13, line 7, which shows a host device receiving requests from a client in a Web-based system); and

(b) in response to the receiving step, sending a Web page containing a question and a list software tool embedded therein to the remote client, wherein the list software tool generates a graphical user interface (GUI) including instructions to a user to enter an answer to the question provided by the Web page (see column 11, lines 46-57, which shows sending an HTML document, i.e. a Web page, to the client comprising test questions; see also column 4, lines 37-44, which shows providing questions and interactively gathering responses, and lines 63-66, which further shows that the presentation, i.e. the graphical user interface, is automated or generated; see also column 16, lines 37-49, which shows providing instructions for responding to or answering the questions);

(c) wherein the list software tool permits a predetermined number of attempts by the user to enter a correct answer (see column 30, lines 35-54, which shows permitting a predetermined number of attempts by the user to work on a test part, i.e. to enter a correct answer, and column 15, lines 57-60, which further shows that a test part may be defined as one question).

With respect to claim 8 (original), Sonnenfeld further discloses the limitation wherein the Web page comprises a page of an on-line educational course (see column 8, lines 61-67, which shows that the test is part of an Internet instruction course).

With respect to claim 9 (original), Sonnenfeld further discloses the limitation wherein the Web page includes a software tool tag instructing a browser to execute instructions for running the list software tool (see column 2, lines 46-60, which shows that the system may be defined using HTML, and column 3, lines 12-20, which shows that parts of the system may comprise applets and plug-ins; note that software tool tags are inherently used in HTML to implement such plug-ins and applets).

With respect to claim 10 (original), Sonnenfeld further discloses the limitation wherein the list software tool includes a definition file defining a correct answer to the question (see column 4, lines 52-59, which shows that the system includes a database, i.e. a definition file, for storing information about the questions, such as the correct answers).

With respect to claim 11 (original), Sonnenfeld further discloses the limitation wherein the definition file is separate from a source code for the Web page to prevent a user from obtaining the correct answer by viewing the source code (see column 4, lines 14-25, which shows using external references in the database; see also column 10, lines 19-27, which shows implementing security features to prevent unauthorized access and tampering).

With respect to claim 12 (original), Sonnenfeld further discloses the limitation wherein the list software tool is an applet (see column 3, lines 12-20, which shows that parts of the system may comprise applets).

With respect to claim 13 (currently amended), Sonnenfeld discloses a computer-readable medium for use in an electronic device that provides an on-line educational course (see the title and abstract, and column 8, lines 61-67, which shows providing academic instruction using the Internet), comprising:

(a) instructions for running a list software tool for displaying a question and an answer box to a user, wherein the user can select at least one answer in the answer box to the question (see column 4, lines 37-44, which shows providing questions and interactively gathering responses; see also column 5, lines 37-45, which shows that the multiple choice questions allow the user to select one or more, i.e. at least one, answer);

(b) wherein the list software tool permits a predetermined number of attempts by the user to enter a correct answer (see column 30, lines 35-54, which shows permitting a predetermined number of attempts by the user to work on a test part, i.e. to enter a correct answer, and column 15, lines 57-60, which further shows that a test part may be defined as one question).

With respect to claim 14 (original), Sonnenfeld further discloses the limitation wherein the instructions are executable on a virtual machine (see column 3, lines 12-20, which shows that parts of the system may comprise Java applets, which are executable on a virtual machine).

With respect to claim 15 (original), Sonnenfeld further discloses the limitation wherein the instructions are stored on a server and downloaded to a local processor of the user (see

column 10, lines 28-41, which shows downloading the data from the host server to a local user terminal).

With respect to claim 16 (original), Sonnenfeld further discloses the limitation wherein the medium includes hypertext markup language (HTML) code to reference the software tool (see column 2, lines 46-60, which shows that the system may be referenced using HTML).

With respect to claim 17 (original), Sonnenfeld further discloses the limitation wherein the HTML code includes the question (see column 11, lines 46-57, which shows formulating the test questions using HTML code).

With respect to claim 18 (original), Sonnenfeld further discloses a definition file indicating a correct answer for the question, the definition file being separate from the HTML code to prevent the user from obtaining the correct answer by looking at the HTML code (see column 4, lines 52-59, which shows that the system includes a database, i.e. a definition file, for storing information about the questions, such as the correct answers; see also column 4, lines 14-25, which shows using external references in the database; see also column 10, lines 19-27, which shows implementing security features to prevent unauthorized access and tampering).

With respect to claim 19 (original), Sonnenfeld further discloses the limitation wherein the list software tool is an applet (see column 3, lines 12-20, which shows that parts of the system may comprise applets).

With respect to claim 20 (currently amended), Sonnenfeld discloses an electronic device for providing an on-line educational course (see the title and abstract, and column 8, lines 61-67, which shows providing academic instruction using the Internet) comprising:

- (a) a processor (see terminals 3 and 4 in FIG. 1, which inherently comprise processors);
- (b) a display screen (see terminals 3 and 4 in FIG. 1, which inherently comprise display screens); and
- (c) memory including a Web page having an interactive list software tool embedded therein (see column 11, lines 46-57, which shows an HTML document, i.e. a Web page, with the test questions embedded therein),
- (d) wherein the processor executes the list software tool to generate a graphical user interface on the display screen, the graphical user interface displaying a question, and an answer box to a user to select at least one answer from the answer box to the question (see column 4, lines 37-44, which shows providing questions and interactively gathering responses, and lines 63-66, which further shows that the presentation, i.e. the graphical user interface, is automated or generated; see also column 5, lines 37-45, which shows that the multiple choice questions allow the user to select one or more, i.e. at least one, answer);
- (e) wherein the list software tool permits a predetermined number of attempts by the user to enter a correct answer (see column 30, lines 35-54, which shows permitting a predetermined number of attempts by the user to work on a test part, i.e. to enter a correct answer, and column 15, lines 57-60, which further shows that a test part may be defined as one question).

With respect to claim 21 (original), Sonnenfeld further discloses a browser for locating and displaying the Web page (see column 12, lines 56-65, which shows a Web browser).

With respect to claim 22 (original), Sonnenfeld further discloses a network connection for connecting the electronic device to a computer network (see network 2 in FIG. 1 and column 12, line 66 to column 13, line 7).

With respect to claim 23 (original), Sonnenfeld further discloses input media to allow the user to enter the answer (see column 10, lines 28-41, which shows input from the user to enter responses or answers).

With respect to claim 24 (currently amended), Sonnenfeld further discloses the limitation wherein the list software tool is an applet (see column 3, lines 12-20, which shows that parts of the system may comprise applets).

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Yigdall whose telephone number is (703) 305-0352. The examiner can normally be reached on Monday through Friday from 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (703) 305-4552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

After October 25, 2004, the examiner can be reached at (571) 272-3707, and the examiner's supervisor, Tuan Q. Dam can be reached at (571) 272-3695.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Michael J. Yigdall
Examiner
Art Unit 2122

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**ANTHONY NGUYEN-BA
PRIMARY EXAMINER**